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IN THE

Supreme Court of the United States

OCTOBER TERM, 1941.

No. 6

THE AUTOMATIC DEVICES CORPORATION,
Petitioner,

vs.

SINKO TOOL & MFG. CO.,
Respondent.

BRIEF FOR RESPONDENT, SINKO TOOL & MFG. CO., ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Opinions of the Courts Below.

The opinion of the Court of Appeals for the Seventh Circuit, holding claims 2, 3, and 11 of the Mead patent in suit not infringed by respondent Sinko Tool & Mfg. Co.'s automatic cigar lighter and that said claims are invalid, is reported in 112 Fed. (2d) 335.

The same Mead patent was asserted against Cuno Engineering Corporation charging that a cigar lighter (different from this respondent's) infringed. The District Court of Connecticut held there was no infringement and expressed serious doubt as to whether Mead transcended the

realm of design. The opinion is found in 34 Fed. Supp. 146.

The decision of the Court of Appeals for the Second Circuit in *The Automatic Devices Corporation* v. *Cuno Engineering Corporation*, reversing the District Court and holding the same claims of the Mead patent valid and infringed is reported in 117 Fed. (2d) 361. The conflict between the decisions of the Courts of Appeals for the Second Circuit and the Seventh Circuit is solely on the question of whether claims 2, 3, and 11 of the Mead patent are valid. There is no conflict on the question of infringement because the Sinko and Cuno cigar lighters are structurally different in important particulars.

Jurisdiction.

In view of the lack of conflict between the two Circuits on the question of infringement and because the only conflict is on the question of validity of the Mead patent, this Court granted certiorari in this action, "limited to the question whether claims 2, 3, and 11 of the Mead Patent No. 1,736,544 are valid".

Certiorari was also granted in the Second Circuit case against The Cuno Engineering Corporation, limited in the same way to the question of validity.

Supplemental Statement of the Case.

Petitioner, The Automatic Devices Corporation, does not manufacture or sell any cigar lighters, but is in form a patent holding company for Casco Products Corporation of Bridgeport, Connecticut, which has an irrevocable, royalty-free license and pays all of petitioner's expenses.

Respondent, Sinko Tool & Mfg. Co., an Illinois corporation, for many years has been manufacturing and selling cigar lighters of various kinds for use in automobiles. The device complained of was developed and proven successful by respondent by a test on October 16, 1933.

Petitioner's licensee, Casco Products Corporation, purchased the Mead patent in April, 1934, through a buyer-agent Kirchner, who assigned the patent to Casco's presiden, Joseph H. Cohen, on February 6, 1936, and Cohen later assigned the patent to petitioner, The Automatic Devices Corporation on May 1, 1936 (R. 27-28). Late in 1936 Casco Products Corporation began selling a newly developed automatic cigar lighter to some of its previous customers that had previously been buying in large quantities non-automatic cordless cigar lighters.

In the spring of 1938 respondent began furnishing its Sinko automatic cigar lighter to its customers which had been buying the Sinko non-automatic cigar lighter. Respondent's automatic cigar lighter has been used continuously by the Oldsmobile Company since 1938 and has also been purchased by Willys-Overland Company, Hudson Motor Car Company, Reo Motor Car Company and General Motors trucks (R. 99).

The application for the Mead patent in suit was filed August 24, 1927 and Mead, with the backing of the Jessop Company, undertook to market an automatic cigar lighter in 1928 or 1929 but was obliged to abandon the attempt.

Petitioner's own witnesses said that it was not reliable in operation and it was not acceptable to automobile manufactures. Mr. Cohen, president of Casco Products Corporation, said his company made endless numbers of samples striving to the end of culling out less advantageous features. He testified that when he got far enough along with the automatic lighter, he took it up with their patent attorney, Mr. Johnson, who discovered "that the Mead patent was the one stumbling block" (R. 70). Casco's commercial device, Plaintiff's Exhibit 3, was not made available to the public until late in 1936, more than nine years after the filing date, and seven years after issuance of the patent in suit.

Assignment of Errors.

It is noted that the assignment of errors appearing on page 4 of petitioner's brief is quite different from the questions presented and the specification of errors appearing on pages 2 and 5 of its petition for certiorari.

Petitioner in its conclusion on pages 49 and 50 of its brief states that the Court of Appeals for the Seventh Circuit erred in holding the Mead claims were not *infringed* by respondent's device and asks that the case be remanded for further proceedings on the issue of infringement.

As this Court granted certiorari in this action expressly "limited to the question whether claims 2, 3, and 11 of the Mead patent No. 1,736,544 are valid", it is clearly improper to attempt now to reargue infringement and we ask that the Court strike pages 39, 49 and 50 of petitioner's brief and refuse to consider questions of infringement.

Summary of Argument.

PAGE

The decision of the Court of Appeals for the Seventh Circuit discusses more fully the primary defense of non-infringement rather than invalidity. Certiorari in this case is expressly limited to the question of validity. The Court of Appeals for the Seventh Circuit was very conversant with the cordless cigar lighter art because of its previous review of other patent litigation on cigar lighters..... 7

The present commercial success of petitioner's licensee, Casco, is immaterial because Mead completely failed to make a commercially acceptable device, and the present successful devices are wholly different in appearance, structure, mode of operation, and convenience..... 8

Mead was not the first to disclose an automatic wireless cigar lighter and, even if he were, he would not be entitled to claim broadly every kind of an automatic control for any such cigar lighter. Thermostatic controls are commonly applied to every kind of electrical heating appliance..... 10

Patent monopolies are not granted for the mere combined use, or double use, of old devices no matter how convenient or useful the result..... 11

At the time Mead filed his application for a patent, he did not know how to make a satisfactory device and the description in the patent is as vague and general as possible..... 12

The modified device, which Mead attempted to market, with adequate backing, had to be abandoned because it was not reliable in operation and was not acceptable to automobile manufacturers..... 14

The Mead device could never have the convenience and safety features that petitioner has emphasized for the modern devices..... 15

Burnett was the first to show a simple time switch to prevent a cigar lighter from being burned out..... 17

The applications for the Copeland patents were filed before Mead and petitioner failed to carry Mead's dates back of them..... 17

Copeland was the first to provide an automatic thermostatic switch in a cordless or a wireless cigar or cigarette lighter. The first patent shows a device for delivering and lighting a cigarette through the operator's action merely of pressing a button on a thermostatic switch 17

The second Copeland patent shows a device for lighting a cigar merely by thrusting it into a socket. This action closes the switch and the thermostatic switch opens automatically when the cigar is lit, ready to smoke..... 19

Other prior art shows that it is old to provide a push button thermostatic switch, similar to respondent's, in electric flat irons, sterilizing tanks, fireless cookers, fuse plugs, heater plugs, light switches, waffle irons, etc. 22

The Campbell patent shows a heater wherein the circuit is regularly closed by pressing the push button, and is normally opened automatically by the thermostatic switch when the device reaches its opening temperature 23

Mead did not attempt to solve any old and insoluble problem because as soon as wireless lighters became popular, several inventors in different parts of the world had already applied thermostatic controls to them 29

Mead was no pioneer but merely selected an old thermostatic switch for an old wireless cigar lighter in which each of the elements acts in its well known manner. Such a bringing together of old devices is not invention according to the decisions of this Court 30

ARGUMENT.

The Approach by the Court of Appeals for the Seventh Circuit.

In order to understand better the carefully written decision of the Court of Appeals for the Seventh Circuit (112 F. (2d) 335), it may be helpful to explain that in the hearings we stressed our primary defense of non-infringement more that the defense of invalidity. The Court, in the same way, first carefully analyzed the alleged invention, the disclosure in the Mead patent, the claims in suit, and compared the patent with defendant's device. It then examined the prior art and, after writing five pages on the lack of infringement, concluded in one paragraph that in view of the prior art what Mead had done did not amount to invention and that his disclosures amounted to nothing more than mechanical skill.

The Court of Appeals for the Seventh Circuit was very conversant with the cordless cigar lighter art because of its previous review of another suit, by petitioner's sustaining company Casco, against the same defendant, *Sinko* v. *Casco*, 89 Fed. (2d) 916 (C. C. A. 7th). Practically every cordless lighter, automatic or non-automatic, that has been sold by respondent Sinko, has been charged by Casco to infringe. In the earlier litigation Casco asserted some twelve patents against the Sinko non-automatic lighters and eventually all of the patents were held invalid or not infringed by the Court of Appeals. Certiorari was denied by this Court in those cases. In that litigation Morris Patent No. 1,376,154, which was claimed to show the first electric cordless lighter, and respondent's Zecchini Patent No. 1,437,701 (R. 374), which we maintained in a counterclaim was the first practical electric cordless cigar lighter, were eventually held invalid for lack of invention by both the District Court and the Court of Appeals.

Commercial Success.

The present commercial success of petitioner's licensee Casco is immaterial. On page 36 of petitioner's brief, as in the trial court, petitioner contrives to stress the commercial success of Casco's present automatic lighter and attempts to substitute the success of that licensee with a modern device, today, for the complete failure of the best efforts of Mead and the Jessop Company with a Mead device in 1928.

In desperate cases, where the question of invention is close, the courts sometimes consider commercial success *of the patented device* to turn the scale in favor of sustaining a patent. *Altoona Pub. Theaters* v. *Am. Tri-Ergon Corp.*, 294 U. S. 477, 488. However, in the present case the record shows that the device which Mead tried to make under his own patent was a complete failure and had to be abandoned in 1928 or 1929.

Petitioner's Mr. Cohen, one time owner of the Mead patent and president of Casco, testified that, after seeing the Mead device in 1929, Casco had to make endless samples, and it was the latter part of 1936 before they had an acceptable device that they would risk marketing (R. 68-70). Commercial success at such a late date with devices wholly different in appearance, structure, mode of operation, and convenience, illustrates that Mead had earlier been unable to embody the invention in a useful device for the public, and that he had not made such a contribution to the cigar lighter art that should enable him to monopolize the present advances.

Deering v. *Winona Harvester Works*, 155 U. S. 286, 295.

The "Stumbling Block".

Neither Casco nor Sinko received any help whatever from the Mead patent in developing the present day lighters. Petitioner's own testimony is eloquent that after making endless numbers of samples and finally after getting its device far enough along to take it up with its patent attorney, it was discovered "that the Mead patent was the one stumbling block". Petitioner's characterization is apt because of the vague and indefinite description and claims in the patent. Mr. Cohen then quietly bought the Mead patent from the Jessop Company in 1934, five years after Mead's device had failed on the market and a year after defendant had developed its device.

Petitioner failed to supply the public with any kind of a cigar lighter having a thermostat until late in 1936 or 1937, and now seeks to use the patent to block the progress of its competitors in the cigar lighter field. An attempt to go back now and revive, in the form of a broad monopoly, a patent on an ineffective device, that by any measuring stick was a complete failure, can hardly be approved. Certainly such a course of action is not within the spirit or intent of the patent statutes.

Patentable Novelty.

Petitioner wavered so often between its unfounded statement that the Mead patent "discloses the first automatic wireless lighter" and its assertion that it does "not cover every wireless cigar lighter that might have a thermostat", that our Court of Appeals observed: "It is most difficult to determine precisely the point or points of novelty upon which plaintiff bases its claim of novelty" (112 F. (2d) 335, 339).

We will show presently, in discussing the prior art, that Mead was not the first to disclose an automatic wireless cigar lighter and that, even if he were, he would not be entitled to claim broadly every kind of an automatic control for any such cigar lighter. It is well settled by decisions of this Court that no one, by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire the right to prevent others from using the same devices either singly or in other combinations.

Hailes v. *Van Wormer*, 87 U. S. 353, 368.

Office Specialty Mfg. Co. v. *Fenton Metallic Mfg. Co.*, 174 U. S. 492, 498.

Thatcher Heating Co. v. *Burtis*, 121 U. S. 286.

At the time Mead filed his application for a patent, wireless cigar lighters were just coming into common use and thermostatic controls for practically every known type of electrical heating appliance were in wide use. Thermostatic controls are so common that we doubt if the Court can recall any electrical heating appliance that has not been used with a thermostatic control.

It is just as obvious to provide a thermostatic control for any kind of an electrical heating device as it is to place a valve on a pressure tank or pipe line.

Thermostats are used so commonly and unobtrusively that one may be amazed by Mr. Paulsey's testimony regarding the dozens of places in modern homes and in automobiles where thermostats are in daily use (R. 109). He enumerated fourteen thermostats in an automobile alone, and three times as many may be found performing various functions in the modern home. The thermostatic field is so large that his company, W. M. Chase Company, since 1923, has specialized in furnishing thermostats for almost

any desired use. In fact Mead bought the bimetal for his thermostat from that company (R. 152).

In cigar lighters the thermostat performs its common function of a timing device for the heater coil, and Mr. Cohen testified that in Casco's lighters the thermostat is accurately set so that the switch will be released in from eight to ten seconds. Two seconds is the greatest variation allowed in their timing (R. 83).

Petitioner would hardly dare to contend that, when cordless cigar lighters first came into common use about 1928, the first person to whom it occurred that an automatic control would be desirable could rush into the Patent Office and obtain a basic patent on the combination of a thermostat and cigar lighter which would prevent all that followed from using any thermostatic control on a cigar lighter until the patent expired. Patent monopolies are not granted for such a combined use of old devices no matter how convenient or useful the result.

Altoona Pub. Theaters v. *Am. Tri-Ergon Corp.*, 294 U. S. 477, 486.

Aron v. *Manhattan Railway Co.*, 132 U. S. 84, 90.

Fond du Lac v. *May*, 137 U. S. 395.

In *Royer* v. *Roth*, 132 U. S. 201, this Court said:

> "There is no patentable combination of the automatic shifting device with the drum of the fulling machine. It is a mere aggregation of parts. The shifting device operates automatically to reverse the action of the fulling machine in precisely the same way that it operates when applied to any other machine; and, the shifting device being old, its application to the fulling machine did not require the exercise of invention. *Double-Pointed Tack Co.* v. *Two Rivers Mfg. Co.*, 109 U. S. 117, 120, 121 (27:877, 878)."

If the new use be so nearly analogous to the former one, that the applicability of a device to its new use would

occur to a person of ordinary mechanical skill, it is sometimes described as a case of mere "double use."

Potts v. *Creager*, 155 U. S. 597, 608.

Walker on Patents, Dellers Edition, Vol. 1, Page 227.

It must be conceded by petitioner, therefore, that there can be no invention whatever in the mere idea of applying a thermostatic control to a cigar lighter, and, if there is any invention at all, it must be in the particular adaptation of a thermostat to a cigar lighter. Accordingly, in searching for invention we must look to the record to see what Mead actually accomplished in trying to carry out his idea.

Mead's Effort to Provide an Automatic Cigar Lighter.

The cordless or "wireless" cigar lighters which were first marketed, and we believe practically all of any commercial importance, closed an electrical circuit through the heating coil by pressing the removable plug, or a push button in the plug, inwardly. After eight or ten seconds, when the igniting coil was sufficiently hot, finger pressure was released and a spring opened the circuit.

Mead does not disclose in his patent how any automatic control can be applied to that commercial type of cigar lighter. Mead's idea was to mount the socket member on a pivot, make an interlocking mechanical connection between the plug and socket, and close the switch by rotating the plug and socket together (like a key in a cylinder lock) into a closed circuit position. His original idea was to rotate the socket and plug back into open circuit position by means of a spiral coil of thermostatic material wound with a phosphor bronze spring and placed in the rotary socket directly opposite the heating element of the plug member. It is well known that spirally wound thermostats are very sensitive to small changes in temperature and

will give considerable movement, but are weak in mechanical power. Obviously in a cigar lighter the change in temperature is large and considerable mechanical power is desirable.

Mead was unable to find a thermostatic material, before filing his application for a patent, that would stand up under the intense heat and he had experimented for some time trying to find a satisfactory arrangement. Just before his patent application was filed in August, 1927, Mead wrote (R. 219):

> "Would rather not use phosphor bronze compensator spring, but if it is necessary it will act about the same as the spring on a snubber. It will expand inside the thermostatic spring, and thereby keep a constant tension on the thermostatic metal. This metal does not seem to have the life that phosphor bronze does, and also has a tendency to stretch. Ask the patent attorney if this part cannot be covered temporarily until the exact design, and gauge of metal is decided upon."

Instead of delaying the filing of the application until an operative device could be worked out and explained by the inventor, the application was prepared showing several modifications of the thermostat, and the description of that all important element was made as vague and general as possible. The claims, instead of claiming the structure, called for nothing but the functions. Not one of the claims in suit mentions either a thermostat or a spring. It is essential to a valid patent that not only must the inventor know how to make such a device but he must describe it in such clear and definite language that those skilled in the art can understand it. That is the consideration to the public for grant of a patent monopoly.

Merrill v. *Yeomans*, 94 U. S. 568, 574.

That the description in Mead's patent is insufficient is further evidenced by the fact that he himself was never successful in applying any thermostat in any of the various

ways described or shown in the patent. He said that plaintiffs' Exhibit 33 was made in the fall of 1927 and that it was the first model that he would care to submit to anybody (R. 160). Later, when the Jessop Company backed him in an attempt to market a modified Mead device in 1928 and 1929, he abandoned the spring, put the coil thermostat outside of the rotary socket and attempted to make the thermostat do the work of the spring (see plaintiffs' Exhibit 7).

The modified device was shown in the Montgomery Ward catalogue in the fall of 1928 and winter of 1929, but the device was admittedly not reliable in operation and was not acceptable to automobile manufacturers. Although one witness of petitioner testified that possibly 1,500 or 2,000 of the devices were sold in 1928 or 1929, it is significant that petitioner failed to produce a single witness who ever bought or used one of the devices for its intended purpose. Although testing equipment was available in the District Court, and the modern devices were fully demonstrated, not one of the Mead devices was operated or demonstrated. The only evidence of operation was the statement by petitioner's president, Mr. Arthur Johnson, that he had made an *ex parte* test the day before the hearing and that it worked very well. We will not stop to mention the decisions on the weight given to such *ex parte* tests.

Modern Cigar Lighters Compared With the Mead Device.

Respondent Sinko and petitioner's licensee, Casco, each developed its commercial lighters without the slightest help from the alleged Mead invention. Defendant took the plug member of its Zecchini Patent No. 1,437,701 (R. 376) and placed a simple claw-like thermostat inside the plug, back of the heating element, so that it would grip the inner end of the push button and hold the circuit closed until the heating element was hot enough for use. Thermostatic push button switches were well known in the electrical heating element art and available to make respondent's manual type of cigar lighter switch thermostatically controlled. Respondent's cigar lighter did not even resemble the Mead device in appearance, structure, method of operation, or convenience.

The Mead device, even if it could have been made to work with its three-dimensional movements, never could have the convenience and safety features that petitioner has emphasized for the modern devices. Even though it might not be necessary to hold the knob of the Mead device during the heating period for a few seconds after it had been twisted to the "on" position, that saving in time would be offset by the inconvenience of fitting the plug back into the socket after use (like a key in a lock), because the latch and bump on the plug member must be aligned perfectly with the proper slots in the rotary socket member. If the pin happened to slip into the wrong slot, the plug could not be fully inserted and it would have to be withdrawn to make another attempt to find the right slot.

To operate the modern lighters one merely presses the knob inwardly with one finger. This action telescopes the contact into the jaws of a thermostat until such time as the thermostat is too weak to withstand the pull of the

spring. All modern lighters fit into the socket at any radial position.

Mead has a three-dimensional movement. He pushes the plug in to make one contact, but must grasp the knob with at least two fingers and rotate the entire plug, with the slotted socket member, until the latch arm snaps over a hump on the lateral base contact to close the circuit. Mr. Johnson, petitioner's president, pointed out other inherent defects in the Mead device (R. 36). It is significant that the Mead patent makes no mention of the alleged convenience or safety that is now asserted by petitioner for Mead.

The Prior Art

Automatic Cigar Lighters.

Burnett (R. 320).

Burnett Patent No. 972,811, issued in 1910, discloses a cigar lighter for a cigar store counter and has a safety device to prevent protracted heating which might burn out the fine resistance wire. To use the device the customer merely depresses the handle 25 which causes a pool of mercury to be dumped into a pocket containing the circuit closing contacts 19 and 21, thereby closing the circuit. While the handle is depressed in this manner (see Figure 3) the mercury slowly trickles down through a contracted passage 23 until its level is so low that it uncovers the terminal 19 and thereby opens the circuit (see Figure 4). If the customer obtains a light before that, but forgets to release the handle, the mercury switch automatically shuts off the current after a predetermined time has elapsed.

Copeland 1,838,363 (R. 434).

According to the evidence in the present suit Copeland was the first to provide a thermostatic switch in a cordless or wireless cigar or cigarette lighter. He filed two patent applications before Mead. His first application was filed March 9, 1927, more than five months before Mead, and his Patent No. 1,838,363 issued in 1931. Petitioner failed in its desperate attempts to carry Mead's dates back of either of the Copeland applications. None of the courts found petitioner was successful in its attempts.

The illustration in Copeland Patent No. 1,838,363 (R. 434) shows a cigarette dispensing device wherein the cigarettes drop down onto the curved arms 28 with one end

of the cigarette in contact with the heating element 27. The circuit through the heating element is closed, either by continued manual pressure on handle 21, or by momentary pressure on a thermostatic push button time switch illustrated in Figure 10. When the button 21 is thrust inwardly, it buckles the centrally disposed leaf spring which in turn presses the thermostatic arm inwardly, closing the circuit at the contact 38. The electric current flows from one terminal of the battery through the igniting element 27, switch contact 38, through the bimetal element, and through a heating coil around the bimetal element back to the ground connection of the other terminal of the battery. As the bimetal arm is heated up by current flowing through it and through the heating coil surrounding it, it buckles outwardly against the leaf spring until it snaps the button 21 back into the position shown in Figure 10, and opens the contact 38.

Apparently from the description in the patent, Copeland felt that adding a thermostatic switch to a cigar lighter was mere mechanical skill and no detailed description or claim was needed. On page 2, lines 87-96, he simply said:

> "However, as indicated in Fig. 10, I may provide a switch 38 in the circuit, arranged to be closed by the employment of the slidable dispensing element 18, said switch adapted to be opened by a thermostat when a predetermined temperature is reached. This would obviate the necessity of the operator's holding the slidable dispensing element in rearward position during the time the cigarette is being lighted."

Copeland 1,844,206 (R. 440).

About a month after filing the application for the patent described above, Copeland applied for another patent. This device is also designed for attachment to the instrument board of a car. To obtain a light, a cigar, illustrated by dotted lines in Figure 2, is merely thrust through the opening against the heating element 14, which is hinged at 22 and bears against a buckling spring 23 adapted to be buckled against the thermostatic bar 24 and close the circuit at the contact 28. It is not necessary to continue to hold the cigar in contact with the heating element. The operation of the thermostatic switch is substantially as described above. In other words, when the thermostatic bar 24 becomes sufficiently warm it will force the buckling spring 23 and hinged igniting element outwardly a short distance and cause the circuit to be opened at the contact 28. This would cause the cigar to move out a little, and the spring will snap. For a further indicator a small light 31 is connected in series to shine only when the circuit is closed.

In the modification shown in Figure 6, the thermostatic time switch is mounted above the opening for the cigar, and the push button 33 contains a small light bulb for a closed circuit signal. When the button 33 is pushed inwardly to close the circuit, it stays in and the light is turned on until the thermostat automatically snaps off the current, causing the push button to pop out and the light to go out. It may be further noted that in both forms the resistance element is detachably mounted on the lower end of the guide member 11 by a bayonet joint.

Petitioner in its brief attempts to make a big point of the fact that Copeland's thermostat receives heat from a little booster heating coil wrapped around the bimetal thermostat rather than relying solely upon heat coming directly from the igniting element. There seems to be little

or no merit in this point because, as we will show, many simpler thermostatic switches do not have the booster coil. After all, the automatic control is merely a timing device and according to petitioner's own testimony the modern devices are carefully timed to work in from eight to ten seconds (R. 83).

Copeland's auxiliary booster coil merely insures more accurate timing. Apparently petitioner was unable to convince the Court of Appeals for the Second Circuit that Mead made any invention in omitting this feature because, in the Cuno case, in discussing this Copeland patent, *Automatic* v. *Cuno*, 117 Fed. (2d) 361, 363, the Court said parenthetically:

> "(The thermostat was not actuated by the heat of the glow member as in Mead, but by a separate resistance coil so timed as to break the circuit at the proper moment. That was, however, a difference of detail in design on which Mead's invention cannot rest.)"

In the same decision the Court attempts to summarize "the strength of the defendant's argument which prevailed in the Seventh Circuit". We do not know how such information could have been before the Court of Appeals in the Second Circuit, but we do know that it is not the argument which was made. The Morris Patent No. 1,376,154 referred to is not even of record in this case.

The Court of Appeals for the Seventh Circuit, in the present case, *Automatic* v. *Sinko*, 112 Fed. (2d) 335, 341, said:

> "It is obvious that there is nothing found in defendant's device which is not found in Zecchini, and in Copeland No. 1,844,206 and we think the same may be said with respect to Mead. Plaintiff, however, contends that Copeland's device is not an automatic wireless cigar lighter. With this we cannot agree. Of course, all cigar lighters have wires whether they be automatic or what is termed wireless, that is to say they have those wires which conduct electricity. We suppose, however, that a wireless cigar lighter is com-

> monly understood to mean one in which all connection of the plug to the device is severed when the plug is withdrawn from the socket. But even so, we think Copeland is an automatic wireless cigar lighter. It is not only wireless in the popular sense, but it is plugless. It provides for the insertion of a cigar in the socket instead of a plug, and the cigar is lighted before it is withdrawn from the socket."

Respondent's present lighter plug containing the thermostatic switch is just as useful in a desk lighter, where it is not removed from the socket or holder to light a cigar, as in a detachable socket member. Defendant's Exhibit O shows such a construction for use on a cigar store counter. The action of the thermostatic switch is wholly independent of the kind of socket used. Two current supply wires connected to the plug contacts is all that is required.

Nothing is said anywhere in the Mead patent in suit about the cigar lighter being "wireless", or cordless, and no mention is made of a thermostat or spring in the claims in suit. Mead made no point of putting a thermostatic switch in a *wireless* lighter as contrasted to any other kind of a cigar lighter. He does say in claims 2 and 3 that the heating member is removable, but in Copeland (R. 441) it is pointed out that the igniting element is supported on the end of a tubular extension by means of a bayonet joint 17 "so that the igniting element may be conveniently inserted or removed without disturbing the other parts of the device".

While it is only fair to say that Copeland does not intend to take off the heating element to light a cigar, the plain language of the Mead claims is broad enough to read on Copeland and therefore be invalidated by it. Plaintiff seeks to avoid this patent by reading into the claim a limitation of "wireless" automatic lighter, although the term does not appear anywhere in the patent. Even if it did, there would be no invention in applying a thermostatic

switch to a wireless lighter as contrasted with Copeland, which our Court of Appeals correctly described as being not only wireless in the popular sense, but plugless.

With Copeland, the driver of a car at his convenience may momentarily remove one hand from the wheel to insert his cigar in the socket and later remove it ignited, while Mead requires three trips to the lighter with much more distraction from the wheel in handling the plug with its red hot igniting coil. In Copeland, the automatic switch can be closed by pushing a button, as respondent does, or by merely thrusting a cigar into the socket. When the cigar is lit, the switch cuts off the current and the cigar is ready to smoke. The automatic switch eliminates the danger of burning out Copeland's coil. In Mead the heater member must first be twisted to the on position, and when it later turns off, the driver must go back quickly to remove the plug, juggle it against the cigar while driving with one hand, and finally he must fit the plug detents back into the proper interlocking slots in the rotary socket.

Other Prior Art.

Hadaway, Jr., Patent No. 1,046,777 (R. 326) shows an electric flat iron provided with a thermostat 4 which, under the influence of the heating element, will swing the arm 12 over to release the latch 23 and open the electric circuit. The circuit can be closed again by pressing the push button 22. It may be noted that the push button switch and heating element are confined in one unit, just as respondent's push button switch and heating element are both in the plug member of the cigar lighter. If the electric light cord leading to the flat iron is detachable, as is the case in practically all flat irons, the device might be described as an automatic "wireless" flat iron having a thermostatic push button switch.

Cavanaugh Patent No. 1,294,047 (R. 348) has a removable or wireless plug member 8, which serves as a switch key or knob, and is normally held down in closed circuit position by a thermostatic latch 9 until the latch is released by the action of heating coil 10. The plug will then pop out to a position where it can be completely withdrawn from the socket unit. The removable plug is shown detached in Figure 5.

Pelton and Hand Patent No. 1,397,777 (R. 354) shows a sterilizing tank of the type commonly found in the offices of dentists and surgeons. If the sterilizing unit boils dry or gets too hot, the thermostat "r" releases the switch "i" and allows the push button or knob "l" to pop outwardly. The current will then remain shut off until the push button is thrust inwardly.

Webster Patent No. 1,400,646 (R. 358) shows an electrically operated heating element which may be incorporated in the stopper of a hot water bottle for therapeutic purposes. It has a make-and-break thermostat 19 which controls one of the heating circuits automatically in order to maintain a substantially uniform temperature.

Campbell Patent No. 1,416,263 (R. 364) shows a fireless cooker whose snap-out push button switch 12 is controlled by the thermostat 5. This patent is of interest because petitioner asserts that the prior art references have a thermostatic control which is only intended to operate under emergency conditions. Petitioner also attempts to avoid some of the references because a booster coil is provided to assure quick action of the thermostat. The present reference is not open to any of these objections.

The thermostat is operated solely by the heat from the heating unit 1. The push button switch 12 is depressed to turn on the current and the circuit remains closed until the

unit reaches the desired operating temperature, whereupon the thermostat automatically opens the circuit permanently, or at least until the operator again depresses the button, as in a cigar lighter.

Petitioner in its main brief complains that there is nothing about this patent to suggest the use of a thermostat in a cigar lighter, but such a remark does not avoid the facts that like in a modern cigar lighter the thermostatic switch is also closed by a push button, that this device is regularly brought up to full operating temperature under the control of the thermostatic switch, that as in a cigar lighter the thermostat is operated by heat coming directly from the resistance unit, and that the automatic thermostatic switch can only be reset manually. In other words, the thermostat in this patent normally performs all of the functions in the same order as the thermostat in a cigar lighter. Other patents show how a thermostatic switch to perform these functions can be made of a size and in a way to fit into a cigar lighter plug.

Donle Patent No. 1,431,220 (R. 370) shows a thermostatic circuit breaker which may be used in place of an ordinary fuse plug. When the thermostat 3a in Figure 3 warms up sufficiently to open the latch 4, the circuit is broken. After the thermostat cools, it can be re-engaged by pressing in the push button 5. This patent shows that there is no difficulty in putting a simple thermostatic switch into a small space.

Zecchini Patent No. 1,437,701 (R. 376). This patent is owned by respondent Sinko and shows all of the main features of the device complained of except the thermostat. Figure 7 shows the removable plug mounted in the socket so that the electric circuit may be closed between the members 13 and 15′ by depressing the button 16. The only change needed to make the Zecchini lighter automatic

is to place a simple claw-like thermostat on the member 13 to engage releasably the head 15'. The Court of Appeals for the Seventh Circuit held that in view of the art on thermostatic switches such a change would not amount to invention.

It is interesting to note that in other litigation between Casco and Sinko, although it was undisputed that this patent was the first to show a wireless or cordless cigar lighter having the heat storing coil that is now used in practically all wireless or cordless lighters, the patent was held by the District Court and the Court of Appeals to be invalid for lack of invention. *Casco* v. *Sinko*, 116 Fed. (2d) 119.

Norden Patent No. 1,556,246 (R. 388) shows a rotary thermostatic switch mounted on an electric light socket and serving as a timing device to delay turning off the current until some definite time after the switch has been operated manually. The bimetal thermostat is marked 22 and the latching pin 20 corresponds to Mead's latch pin 75 on his cigar lighter plug. Mead was actually trying to work out a switch of this type for his cigar lighter and perhaps would have been more successful had he followed more closely the teachings of this prior patent.

Haugh Patent No. 1,563,854 (R. 394) shows a spring pressed switch for a flat iron plug. When the bimetal thermostat 9 becomes sufficiently warm to unlatch, the switch snaps over to open circuit position. As the switching device is detachable, and the flat iron may be used after heating up while detached from the socket member, we assume that petitioner to be consistent would have to call the flat iron a wireless or cordless flat iron.

Reid Patent No. 1,565,499 (R. 400) shows an electric flat iron provided with a push button 27 which is latched in

closed circuit position, after being pressed in, by means of a thermostatic coil latch 37. Certainly all of the heat which can affect the thermostat comes from the heating element 11.

It will be seen that in the Reid device, like Hadaway, Jr. (R. 336), is found the same essential elements and arrangement in the combination that is found in respondent's cigar lighter plug. The flat iron may be pulled away from the socket containing the current supplying terminals, while the iron is being used. It contains a thermostat, which is operated from the heat of the heating element itself, to release a push button switch when the iron reaches a predetermined temperature. After the thermostat has released the push button, the current can only be turned on again by pressing the push button 27 inwardly, just as in respondent's device.

Achiele Patent No. 1,614,169 (R. 404) shows a compact thermostatic switch which may be used in place of the ordinary fuse plug. The push button 17 is held in closed circuit position by thermostatic arm 21 so that the current flows through the thermostat. If too much current is passed through the thermostatic arm, it will heat up, curl back and permit the push button to pop out into open circuit position.

Sandin Patent No. 1,630,358 (R. 412) shows another thermostatic safety plug. The device is of about the same size and has the same general arrangement of the thermostatic switch as in respondent's cigar lighter plug. The plug has in one end a heating element 11 through which electric current will pass when the push button 17 has been thrust inwardly, as indicated in Figure 1, to close the circuit between the end terminals 6 and 7. When the coil 11 reaches a predetermined heat, the thermostat 15 will move upwardly to raise the latch 19 and permit the push button

17 to spring back into open circuit position indicated in Figure 2, under the influence of the helical spring 22. An adjusting screw 26 is provided so that the thermostat may be very accurately adjusted. The patent states, page 2, lines 38-42:

> "By reason of this adjustment, the cut-out mechanism may be made to operate at different time intervals with a given current or at equal time intervals with different currents."

Respondent uses a thermostatic push button switch of the type shown in Sandin, in the plug of its Zecchini wireless lighter; see Figure 7 of the Zecchini patent (R. 376). This arrangement, although very simple, is wholly different from anything shown or suggested by the Mead patent in suit.

Arneson Patent No. 1,689,007 (R. 418) shows a thermostatic push button switch for the socket member of a flat iron. Respondent, Sinko, manufactured over 10,000 of these devices long before the application for the Mead patent in suit was filed. Mr. Sinko explained the operation in detail (R. 88-91) and Defendant's Exhibit D is a sample of the device. Briefly, the current to the flat iron is turned on by pressing the red button inwardly. When the iron reaches a predetermined heat, a thermostat trips a little lever and the button pops outwardly indicating that the current has been shut off. The thermostat will not reengage until the red button is again pressed inwardly.

Carmean, et al. Patent No. 1,780,462 (R. 426) shows a simple push button thermostatic control for electric heaters of the type used in waffle irons, coffee pots, etc. The application was filed more than a year before Mead filed. The thermostatic bimetal element 29 is curved at 32 so that when it reaches a certain heat it will press the end 24 of the switch outwardly and unlatch it so that it will snap into

open circuit position, as shown in Figure 2. The circuit is closed by pressing the button 38 inwardly.

There is no booster coil around the thermostat and the thermostatic element is operated by heat coming directly from the heating element 14. In other words, like in the modern lighters, the thermostatic element is heated by radiation and conduction of the air from the heating element.

It is stated on page 26 of petitioner's brief, after discussing the above patent, that the Seventh Circuit Court of Appeals erred when it held that the same principle of thermostatically disconnecting the circuit had been used in the manufacture of electric irons, and the like. Respondent says that "in not one of these prior art patents is the thermostat operated to permanently open the circuit solely by and in accordance with the temperature of the resistance and when the resistance reached a predetermined temperature at which it is to be used."

Manifestly even the Mead patent does not fit into that narrow definition because the Mead thermostat is not in direct contact with the heating element, but, as in the prior art devices, is heated by radiation or air conducted heat from the heating element. Any other interpretation of the claims of the Mead patent would invalidate them as not reading on the Mead disclosure. However, we think that when claims 2 and 3 state, "means responsive to the temperature of said heating unit", they of course mean temperature conditions produced by the heating unit around the thermostat, just as in the prior art devices and the modern devices.

To be as technical as petitioner would be in its above statement, it is not correct to state that in Mead the current is shut off when the resistance reaches a predetermined temperature at which it is to be used, for obviously,

as soon as the current is shut off, the heating element cools rapidly and will be at a lower temperature before the plug possibly can be withdrawn and applied to a cigar. Only in Copeland is the igniting element in contact with a cigar at the instant the switch opens.

As we have previously brought out in discussing Campbell Patent No. 1,416,263 (R. 364), in that device the thermostat, within the meaning of petitioner, is "operated permanently to open the circuit solely by and in accordance with the temperature of the resistance and when the resistance reaches a predetermined temperature at which it is to be used".

Mead Was Not Attempting to Fill a Long Felt Want.

Mead did not attempt to solve any old and therefore insoluble problem in wireless lighters, because wireless lighters only became popular in 1928, about the time that Casco and Sinko entered the field (R. 68). At that time several inventors in different parts of the world had already applied thermostatic controls to some forms of wireless lighters.

The earliest publication in evidence disclosing a wireless cigar lighter using the thermostat is dated October 18, 1927, in "The Motor" (R. 233). This is a British publication and mentions the same manufacturer and shows practically the same device that is illustrated in Smith British Patent No. 285,200 (R. 481). While the patent indicates on its face that it was filed in 1926, under the rules of evidence, a foreign patent must rely upon its publication date, which was a little after Mead's filing date of August 24, 1927. We only call attention to the fact that Smith, independently, did have a wireless lighter with a "hunting" thermostat which served as a safety device to prevent overheating and burning out of the element. The circuit was held closed manually.

Rupps British Patent No. 298,073 (R. 493) is a little too late to be prior art against Mead but it does show an automatic wireless cigar lighter with a "hunting" thermostat, developed in 1927. Petitioner is mistaken on page 29 of its brief when it indicates that the operator must hold the circuit closed manually. The plug is merely turned to the "on" position, and after reaching the desired heat, the thermostat keeps it hot until the operator at his convenience removes the plug.

Of course, Copeland was the first to apply an automatic thermostatic switch to a cigar lighter, so far as the record shows, but it is clear that other independent inventors in various parts of the world had no difficulty in applying automatic thermostatic controls to wireless cigar lighters at about the same time, showing there was no old or insoluble problem. At that time there was no public demand because wireless lighters were just coming into common use. The device merely awaited public acceptance.

Altoona Publix Theatres v. *American Tri-Ergon Corp.*, 294 U. S. 477, 488.

Paramount P. Corp. v. *American Tri-Ergon Corp.*, 294 U. S. 464, 476.

What Did Mead Teach the Art?

Broad patent monopolies are only granted to real pioneers who make some worthwhile discovery or solve some old and theretofore insoluble problem. It is manifest that there was no old or insoluble problem in wireless lighters, and that there was no more difficulty in selecting a suitable thermostatic switch for a wireless cigar lighter than in any other kind of a cigar lighter.

Mead did not claim to be a pioneer. The preamble to the patent specification (R. 283) modestly describes its objects as being a cigar lighter "simple and cheap in manufacture and more efficient than devices used heretofore".

The means for obtaining thermostatic control are described without claim of novelty and without emphasis over other elements which are also all found in the prior art.

Copeland (R. 440) was prior to Mead and shows various ways of providing thermostatic controls for a cordless cigar lighter, including a snap-out push button switch. Sandin (R. 413), who was long ahead of Mead, shows a thermostatic switch much more like respondent's than Mead's. By going still further back to Burnett (R. 320) a cigar lighter is found in 1910 with the time switch to turn off the current automatically and prevent injury to the heating element.

The mere selection of an old thermostatic switch for an old wireless cigar lighter in which each of the old elements act in their old and well-known manner is not of itself patentable invention. The prior art shows thermostatic switches of various types which have been applied to practically every known electrical heating device. An aggregate of old results is not invention.

Hailes v. *Van Wormer*, 87 U. S. 353.

Office Specialty Mfg. Co. v. *Fenton Metallic* [illegible] *Co.*, 174 U. S. 492, 498.

This Court has repeatedly held that where the public has acquired in any way the right to use a machine or device for a particular purpose, it has the right to use it for all like purposes and no one can take out a patent to cover the application of the device for a similar purpose.

Blake v. *San Francisco*, 113 U. S. 679.

It follows therefore that if the Mead patent has any patentable novelty at all, it must be in the specific way described in his patent for attaching a thermostatic control to a cigar lighter. However, the particular claims in suit, according to petitioner's interpretation, are broad and on their face contain no limitations as to the use of a thermostat, spring, rotary socket, rotatable plug, or the like.

In the Court of Appeals for the Seventh Circuit plaintiff took the position that the Mead patent should be interpreted to cover the principle or function of a thermostat in a wireless lighter. Defendant pointed out that the principle or function of an invention is not patentable and that this Court at any early date held that a patent is not good for an effect because that would prohibit all other persons from making the same thing by any means whatsoever. This Court long ago decided that such patents by creating monopolies would discourage arts and manufacturers, and were contrary to the avowed policy of the patent laws.

LeRoy, et al. v. *Tatham, et al.*, 14 Howard 156.
O'Reilly, et al. v. *Morse, et al.*, 15 Howard 62.

Conclusion.

No attempt has been made in this brief to set forth respondent's primary defense of non-infringement, urged in the Court of Appeals for the Seventh Circuit, because in granting certiorari this Court limited the question to the validity of claims 2, 3, and 11 of the Mead patent.

The Mead patent teaches nothing that can be used in the cigar lighter art or that Mead himself was able to use in his later unsuccessful attempt to make an acceptable commercial device. At most he merely selected an old thermostatic switch to be used with an old cordless cigar lighter. Even his selection was inapt.

The modern automatic cigar lighters were developed independently, without any help from the Mead disclosure, and respondent's lighter is wholly different from the Mead device in appearance, structure, mode of operation, and convenience.

The evidence shows that it was old to use thermostatic switches in electric heating devices of practically all kinds. Mead was not even the first to use such a switch in a cordless cigar lighter, and push button thermostatic switches of the general type used by respondent had long been known and used in many devices, such as flat irons, which may be pulled away from the terminal socket and used as a "wireless" device after being automatically heated to a desired temperature. The doubtful character of Mead's contribution to the cigar lighter art clearly does not entitle him to claims 2, 3, and 11 in the scope contended for by petitioner, and whether the more specific claims to a rotatable socket could be sustained is not in issue here.

It is contrary to the spirit and intent of the patent statutes to permit an enterprising company to resurrect and broaden by construction, to cover modern devices, claims

of a patent which failed even to disclose a meritorious device. Such a patent cannot be used to stifle the progress of other inventors and thereby deprive the public of the benefit of the competition to which it is entitled.

For the above reason, it is urged that the Court of Appeals for the Seventh Circuit should be affirmed in holding the claims in suit invalid.

Respectfully submitted,

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